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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ichiro Fujita

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10/06/2006

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EXAMINER

PORTER, RACHEL L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,699

Applicant(s)

FUJITA, ICHIRO

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8, 10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8, 10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 7/12/06. Claims 5-8, 10 and 12 are pending.

Drawings

2. The objection to the drawings is hereby withdrawn due to the response filed 6/12/06.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/12/06 has been entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-8, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Exemplary claim 5 recites: "wherein the request data for insurance includes produce data specified by a user terminal *from purchase data stored in said first computer storage...*" It is unclear to the Examiner how the phrase "from purchase data stored in said first computer storage" is intended to modify the current claim.

Claims 6-8 inherit the deficiencies of claim 5 through dependency and are therefore also rejected.

Claims 10 and 12 include similar language to claim 5, and therefore a similar analysis applies.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-6, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (USPN 6,347,302) in view of Thomson et al (US 2003/0061104 A1).

[claim 5] Joao a system for mediating the transmission of information among users via a network, said system comprising:

- a first computer storage part in which purchase information related to products possessed by said at least one user is stored; (col. 2, lines 33-49; col. 5, line 59-col. 6, line 6; lines 50-57)

- an insurance request part which requests insurance on said products according to said purchase information stored in a first computer storage part. (col. 8, lines 41-61)

Joao teaches a system which includes a first storage stores purchase related information on products possessed by the user and also includes an insurance request component as explained above. However, Joao does not expressly disclose a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured.

Claim 5 further recites that the system includes each of a user terminal, a manufacturer terminal and an insurer terminal and that the system comprises:

a second computer storage part in which at least an identifier of a product and guarantee information related to said product are stored for each product available from said at least one manufacturer; and

an insurance request part which sends request requests data for insurance on said products to the insurer terminal, wherein the request data for insurance includes product data specified by a user terminal from purchase information stored in said first computer storage and data, related to the product data stored in said second computer storage.

Thomson et al discloses a system further comprising:

- each of a user terminal, a manufacturer terminal and an insurer terminal (par. 49-50; Figure 13) and:

Art Unit: 3626

- a second computer storage part in which at least an identifier of a product and guarantee information related to said product are stored for each product available from said at least one manufacturer; and (par. 56-57, 59,69-71)
- an insurance request part which sends request requests data for insurance on said products to the insurer terminal, wherein the request data for insurance includes product data specified by a user terminal from purchase information stored in said first computer storage and data, related to the product data stored in said second computer storage. (par. 56-57,61-67)

At the time of the Applicant's invention, it would have been obvious to modify the system of Joao with the teaching of Thomson to include a user, the manufacturer, and insurer, and to have information provided supplemented by the necessary parties as needed. As suggested by Thomson, one would have been motivated to include these features to so that the manufacturer gains valuable information about the long term satisfaction of customer and to allow the customer to gain important product information regarding recalls, thereby promoting brand loyalty. (Thomson, abstract)

[claim 6] Joao and Thomson teach the system as claimed in claim 5 as explained in the rejection of claim 5. Furthermore, Joao teaches a system wherein said insurance request part sends information includes at least maintenance of the product (col. 9, lines 15-40).

Art Unit: 3626

[claim 10] Joao teaches a method of mediating between users over a network, said method comprising:

- receiving purchase information related to products possessed by said at least one user; (col. 5, lines 38-58; col. 9, lines 16-42)
- storing said purchase information in a first computer storage part; and (col. 9, lines 16-42)
- requesting insurance on said products according to said purchase information stored in a first computer storage part. (col. 9, lines 26-col. 10, lines 24)

Joao teaches a system which includes a first storage stores purchase related information on products possessed by the user and also includes an insurance request component as explained above. However, Joao does not expressly disclose a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured.

Claim 10 further recites that the system includes each of a user terminal, a manufacturer terminal and an insurer terminal and that the method comprises

- requesting data for insurance on said products to the insurer terminal, wherein the request data for insurance includes product data specified by a user terminal from purchase information stored in said first computer storage part and data, related to the product data, stored in a second computer storage part, wherein said second computer storage part stores at least an identifier of a product and guarantee information related to said product for each product available from said at least one manufacturer

Thomson et al discloses a system further comprising:

- each of a user terminal, a manufacturer terminal and an insurer terminal (par. 49-50; Figure 13) and;
- requesting data for insurance on said products to the insurer terminal, wherein the request data for insurance includes product data specified by a user terminal from purchase information stored in said first computer storage part and data, related to the product data, stored in a second computer storage part, wherein said second computer storage part stores at least an identifier of a product and guarantee information related to said product for each product available from said at least one manufacturer. (par. 56-57,61-67)

At the time of the Applicant's invention, it would have been obvious to modify the system and method of Joao with the teaching of Thomson to include a user, the manufacturer, and insurer, and to have information provided supplemented by the necessary parties as needed. As suggested by Thomson, one would have been motivated to include these features to so that the manufacturer gains valuable information about the long term satisfaction of customer and to allow the customer to gain important product information regarding recalls, thereby promoting brand loyalty. (Thomson, abstract)

[claim 12] Claim 12 repeats the subject matter of claim 10 a computer readable medium storing instructions, which cause a computer to perform the underlying method, recited in claim 10. As the underlying process has been shown to be fully disclosed and

computer implemented by the teachings of Joao in the above rejection of claim 10, it is readily apparent that the Joao reference includes computer readable medium with instructions to cause a computer to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 10 and incorporated herein.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Thomson as applied to claim 5, and further in view of McMillan et al (USPN 5,797,134—to substantiate Applicant's challenge of Official Notice).

[claim 7] Joao teaches a system for insuring gathering and exchanging information on products from a user and submitting a request for insurance for the products (col. 9, lines 26-col. 10, lines 24), but does not expressly disclose that the insurance request part sends information for collectively insuring a plurality of products with a single insurance contract. However, it is respectfully submitted that it is old and well known in the insurance art to carry multiple coverages on a single contract or to insure more than one item on a single contract. For Example, McMillan et al discloses that a single insurance contract for a product (automobile insurance) may carry multiple coverages (e.g. liability, comprehensive, liability, collision.) (col. 2, lines 1-14). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teaching of Joao and Thomson to allow the user to insure multiple products with a single insurance contract. One would have been motivated to include this feature to streamline the process of insuring the products.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Thomson as applied to claim 5 above, and further in view of Lockwood.

[claim 8] Joao and Thomson teach the system of claim 5 as explained in the rejection of claim 5. Joao further discloses a system that provides insurance quotes and contracts for a product as requested by a user and based upon stored data (col. 9, lines 44-col. 10, line 35), but does not expressly disclose gathering insurance estimates from a plurality of insurers. Lockwood teaches a system which receives estimates from a plurality of insurers and which prepares a contract for insurance with the selected insurer. (col. 2, lines 8-19; col. 5, lines 44-col. 6, line 32) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao and Thomson in combination with the teaching of Lockwood to include gather estimates from a plurality of insurers and to prepare a contract for insurance with the selected insurer. As suggested by Lockwood, one would have been motivated to include these features to allow the prospective insured to quotations from various institutions quickly and easily, and to compare quotations at leisure or obtain a policy on the spot. (col. 3, lines 33-37)

Response to Arguments

10. Applicant's arguments filed 7/12/06 have been fully considered but they are not persuasive.

Art Unit: 3626

(A) Applicant argues the new limitations of claims 5,10, and 12. However, these limitations have been addressed by a new art limitation provided in the current Office Action.

(B) Applicant argues that the combination of Joao and Solomon is improper because Solomon is non-analogous art.

Applicant's arguments with respect to the Solomon reference have been considered but are moot in view of the new ground(s) of rejection.

(C) On page 5 of the 7/12/06 response, Applicant has argued that the term "data mining" does not appear in Applicant's specification, and that Examiner introduced this term in providing a motivation statement. Applicant further counters that there is no burden for the specification to be ultimate authority in providing the full meaning of terms.

In response, Applicant is respectfully reminded that the term in question was "complementary," not data mining. In arguing the limitations and recited features of claims 10 and 12 in the After-final response (page 5, mid-page), Applicant argued that "that the claim language clearly recite that data in both storages are complementary." The Examiner merely stated that the claim language did not recite that the data was complementary and that the specification did not provide any special definitions regarding "complementary data" in the data storage parts.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RP


C. LUKE GILLIGAN
PATENT EXAMINER